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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,316	11/05/2003	Norman Milstein	M 6212C-NHG/ST	7930
23657	7590	08/21/2007	EXAMINER	
COGNIS CORPORATION			HANDY, NIKKI R	
PATENT DEPARTMENT			ART UNIT	
300 BROOKSIDE AVENUE			PAPER NUMBER	
AMBLER, PA 19002			1616	
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			08/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/702,316

Applicant(s)

MILSTEIN ET AL.

Examiner

Nikki Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 93-110 is/are pending in the application.
- 4a) Of the above claim(s) 1-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 93-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 93-110 are pending. Claims 1-92 have been cancelled. Receipt of Applicants' remarks/arguments filed on February 22, 2007 are acknowledged.

Response to Restriction Requirement

It should be noted that Applicants' have requested reconsideration and withdrawal of the Restriction Requirement of Claims 93-109 and Claim 110. The traversal is on the ground(s) that Claim 110 contains all of the limitations of Claim 93, the independent claim directed to the food additive composition. See elements (a), (b), (c) and (d) of the food additive composition recited in Claims 93 and 110. The traversal has been found persuasive. There is rejoinder of Claims 93-109 and Claim 110. Therefore, all claims will be examined.

Provisional Nonstatutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37CFR 3.73(b).

Claims 93-109 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7, 8, 11, 12, and 13-18 of U.S. Patent No. 6,394,230 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application and USPN '230 claim a food additive composition that is useful for lowering cholesterol. The scope of the application claims differs from the USPN '230 claims in that the USPN '230 makes claim to a food additive comprising a reaction mixture formed by reacting at least one member selected from the group consisting of carboxylic acids and carboxylic acid esters in the presence of a catalytically effective amount of a catalyst selected from

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the group consisting of calcium oxide, calcium hydroxide; a calcium salt of a carboxylic acid, magnesium hydroxide and combinations thereof, wherein said reaction mixture includes at least a portion of said catalyst, whereas, the instant application claims a food additive composition comprising: (a) an edible solubilizing agent; (b) an effective amount of a suitable disperant; (c) an effective amount of an antioxidant; and (d) an ester prepared by reacting at least one first reactant selected from the group consisting of sterols, stanols, and combinations thereof with at least one second reactant selected from the group consisting of Carboxylic acids and carboxylic acid esters in the presence of a catalytically effective amount of a catalyst selected from the group consisting of calcium oxide, calcium hydroxide, a calcium salt of a carboxylic acid, magnesium hydroxide and combinations thereof. USPN '230 recites the following: a food additive comprising a reaction mixture, etc. The terminology, **comprising**, is a term which allows for the inclusion of unrecited components. The additional unrecited components in the instant claims are an edible solubilizing agent, an effective amount of a suitable dispersant, and an effective amount of an antioxidant. It would be obvious to one of ordinary skill in the art to include the additional ingredients because the USPN '230 makes claim to the food additive comprising a reaction mixture by reacting at least one member selected from the group consisting of sterols, stanols and combinations thereof with at least one member selected from the group consisting of carboxylic acids and carboxylic acid esters in the presence of a catalytically effective amount of a catalyst alone. The USPN '230 inherently claims the invention of the instant application where

the food additive composition is employed with an edible solubilizing agent, an effective amount of a suitable dispersant, and an effective amount of an antioxidant.

Response to Applicant's Arguments

Applicants' arguments filed on February 22, 2006 have been fully considered but they are not persuasive. Applicants' argue that (1) during a Telephonic Interview, the Double Patenting rejection was submitted in error and is improper because the present application is a Divisional application of U.S. Application No. 6,394,230 B1 (hereinafter '230). The subject matter of the present claims was the subject of a Restriction Requirement in '230, (2) the Office issued a Requirement for Restriction in '230. The Double Patenting rejection of the present application over '230 is prohibited under 35 USC Section 121 and should be withdrawn. Applicant is requesting withdrawal of the Double Patenting rejection of Claims 93-109. The Examiner respectfully disagrees. The subject matter ((in Original Claim 28 of Application Serial No. 09/083,584), where Formula I (carboxylic acid and carboxylic acid esters) and Formula II (stanol) of patent '230 and also Original Claim 28, Formula I (carboxylic acid and carboxylic acid esters) and Formula III (sterol)) of patent '230, was not restricted in the parent application, Serial Application No. 09/083,584. Furthermore, since Claim 110 encompasses all the limitations of Claim 93 and has been rejoined with Claims 93-109, Claim 110 is rejected under Double Patenting also. In addition, the Double Patenting rejection of Claims 93-110 is **maintained**.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki Handy whose telephone number is (571) 272-9923. The examiner can normally be reached on Monday-Friday 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Nikki Handy
Patent Examiner
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A handwritten signature in black ink, appearing to read "Johann R. Richter", is written over a horizontal line. The signature is stylized with a large initial 'J' and a long horizontal stroke at the end.

Johann R. Richter
Supervisory Patent Examiner
Technology Center 1600